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| 10/661,557 | 09/15/2003 | Michael S. Katz | 0911.0003C | 9050 |
| 27896 7590 01/07/2009 EDEL, SHAPIRO & FINNAN, LLC 1901 RESEARCH BOULEVARD SUITE 400 ROCKVILLE, MD 20850 | | | | |
| EXAMINER | | | | |
| LUBIN, VALERIE | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3626 | | | | |
| NOTIFICATION DATE | | DELIVERY MODE | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

epatent@usiplaw.com

Office Action Summary

Application No.

10/661,557

Applicant(s)

KATZ, MICHAEL S.

Examiner

VALERIE LUBIN

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-18 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 15 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/5508)
Paper No(s)/Mail Date 9/15/03
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Inventor's Patent Application
6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. Claims 1-18 are pending

For reference purposes, the document paper number is 20081223

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4. Claims 1-11, and 15-18 are rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions. The Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); and *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876), *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008)).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim

should positively recite the other statutory class (the thing or product) to which it is tied. This can be done, for example, by identifying the apparatus that accomplishes the method steps, by positively reciting the subject matter that is being transformed, or by identifying the material that is being changed to a different state.

Claim 1 nominally recites the use of a computer, which is not sufficient to tie the method to an apparatus. The apparatus must be functionally tied to the method.

Claims 2-11 and 16-18, as dependents of claims 1 and 15, are rejected under the above analysis.

5. Claims 12-14 are directed to a computer apparatus comprising software modules, which is not a patent eligible statutory class.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1 rejected under 35 U.S.C. 102(b) as being anticipated by Coli et al U.S. Patent No. 6,018,713.

8. With respect to claim 1, Coli recites a method comprising the steps of (a) defining predetermined tests (Col. 11 lines 44-47); (b) categorizing said predetermined tests into test types (Col. 11 lines 27-30); (c) creating a flow sheet having an array of data cells (Col. 19 lines 35-40); (d) assigning portions of said array to test types (Col. 19 lines 43-46); (e) assigning said predetermined tests to sub portions of the array (Col. 19 lines 41-43); entering into a computer test results (Col. 2 lines 23-24; col. 14 lines 32-36); allocating test result data entered to appropriate tests and (h) entering into the computer date of test information (Col. 14 lines 36-39); (i) transferring the data entered to sub-portions of said array and labeling the transferred data on said flow sheet with said data of entry information (Fig. 12 elements 1218 and 1220; Fig. 20, col. 13 lines 63-64); (j) selectively displaying and positioning test result data and (k) displaying the date of test information entered (Fig. 12 elements 1218 and 1220; Fig. 20, col. 13 lines 63-64).

Claims 7 and 11 are rejected under the analysis of claim 1.

Claims 12 and 14 are also rejected under the analysis of claim 1, as they are directed to the software for performing the method of claim 1.

Claim 15 is rejected under the analysis.

9. Claim 2 is rejected, as Coli recites displaying test result data associated with a date of test information (Fig 20). Furthermore, claim 2 is an optional and not positively recited step, and according to the MPEP, "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation" (MPEP 2106.II.C).

Claims 13 and 16 are rejected under the analysis of claim 2.

10. Claim 3 is rejected, as Coli recites providing visual aids to identify values outside a range bounding value (Col. 14 lines 20-23). Such step first necessitates that a normal range be first established, thus making the establishing of at least one range bounding value an inherent step.

Claims 4, 5, 8 and 9 are rejected under the analysis of claim 3.

11. Claim 6 is rejected, as Coli discloses an array in the form of a matrix of columns and rows (Fig. 20).

Claim 10 is rejected under the analysis of claim 6.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coli et al U.S. Patent No. 6,018,713.

14. With regards to claim 17, Coli recites a test ordering system that directs patients (Col. 3 lines 21-24). He also recites enabling options applicable to a step being performed (Fig. 4 element 404, fig. 5 element 506). It would therefore have been obvious to one of ordinary skill in the art to combine the teachings of Coli to enable options for directing a patient through the method in order to provide a structured process for patients to access test information.

15. For claim 8, Coli does not recite providing graphical chart displays; however Examiner takes Official Notice that such a process was old and well known in the art at the time the invention was made. It would therefore have been obvious to combine the prior art to display test results in graphical format in order to allow for another view of test results and to enable users to quickly identify trends.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Stoodley, U.S. Patent No. 6,611,846 and Kumagai U.S. Patent No. 6,081,809 recite displaying test results using graphical charts.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VALERIE LUBIN whose telephone number is (571)270-5295. The examiner can normally be reached on Monday-Friday 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher L. Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VL

/C Luke Gilligan/
Supervisory Patent Examiner, Art Unit 3626